

REMARKS

This application has been reviewed in light of the Office Action dated July 18, 2003. Claims 15-30 are pending in this application, having been added to replace Claims 1-14, which have been cancelled, without prejudice or disclaimer of subject matter. Claims 15, 22, 24, and 29 are in independent form. Favorable reconsideration is requested.

Claims 1, 2, 8, and 9 were rejected for obviousness-type double patenting over claims 1 and 8 of U.S. Patent No. 5,777,617 (Kishimoto). Claims 1, 2, 8, and 9 also were rejected under 35 U.S.C. § 102(e) as being anticipated by Kishimoto; Claims 6 and 13 were rejected as being anticipated by U.S. Patent No. 6,436,809 (Hayashi); Claims 3 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kishimoto in view of purportedly well-known prior-art; Claims 4, 5, 11, and 12 were rejected as being unpatentable over Kishimoto in view of Japanese Laid-Open Patent Application JP 409130573 (Teramoto); and Claims 7 and 14 were rejected as being unpatentable over Hayashi in view of U.S. Patent No. 6,078,399 (Kadota). Cancellation of these claims renders their rejections moot, but Applicant will address the cited references with respect to new Claims 15-30.

Claims 15 and 24

The aspect of the present invention set forth in Claim 15 is an image processing apparatus having receiving means for receiving image information, wherein the image information includes a code to indicate whether the image information is permitted to be output. A control means is provided for controlling storage and output of the image information. A storage means is provided for storing, according to control by a control means, the image information received by the receiving means. Output means is provided for outputting the image information received by the receiving means in accordance with

the code in the image information. The control means controls the storage means so that the image information output by the output means is not retained in the storage means after the image information is output by the output means.

Kishimoto relates to an output apparatus having a mode in which image data is deleted from a page buffer after being output and another mode in which image data is retained after being output.

Nothing in Kishimoto teaches or suggests image information including a code to indicate whether the image information is permitted to be output and a control means that controls a storage means so that the image information output by the output means is not retained in the storage means after the image information is output by the output means. To the contrary, Kishimoto states that “if...mode B is selected, after the image data has been developed into the image memory 25, the print data corresponding to the image data in the page buffer 23 is not deleted.” Kishimoto at col. 4, lines 34-37 (emphasis added). Moreover, Kishimoto is utterly silent as to a code included in the image information to indicate whether the image information is permitted to be output.

While anticipation is not an *ipse dixit* test, it is well-established that in order for a reference to anticipate a claim “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” MPEP § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The Examiner, citing col. 4, lines 16-20 and 24-27 of Kishimoto, states that:

After, the print mode, test mode A, B or normal is determined (S6), the image information is output (S15), and then deleted from page buffer (23)...

Office Action at 6. However, this description is incorrect, in that, as noted above, if test mode B is selected, the image data is not deleted from the page buffer. Thus, Kishimoto discloses an apparatus that deletes the image information after output in certain modes but

retains it in other modes. This points in a direction different from the objectives of the present invention, as discussed beginning at page 4, such as preventing image information from being used without authorization. More fundamentally, Kishimoto's apparatus clearly does not control output so that the image information is not retained in the storage means after the image information is output by the output means, as recited in Claim 15. Nor, to reiterate, does Kishimoto teach or suggest a code included in the image information to indicate whether the image information is permitted to be output. Thus, Kishimoto cannot reasonably be said to disclose the "identical invention" as that of Claim 15.

Accordingly, Applicant submits that Claim 15 is patentable over Kishimoto.

Independent Claim 24 is a method claim that corresponds to apparatus Claim 15 and is believed to be patentable for at least the same reasons as discussed above in connection with Claim 15.

Claims 22 and 29

The aspect of the present invention set forth in Claim 22 is an image processing apparatus connectable to an image output apparatus including a determining means for determining an output mode in which image data is outputted by the image output apparatus. A conversion means is provided for converting a format of the image data in accordance with the output mode determined by the determining means. A transmitting means is provided for transmitting the image data converted by said conversion means.

Hayashi, as understood by Applicant, relates to transmitting image information over a transmission line. In Hayashi, input image information undergoes a color conversion process, then is separated into a first piece of image data and a second piece of image data, selection data in a multilayer data processing is performed, and finally

transmission data in the multilayer data format is output. If the image information is determined to be a monochrome image, the selection section selects the transmission data in a 1-layer data format and then the transmission data is output.

Nothing has been found in Hayashi that teaches or suggests a conversion means for converting a format of the image data in accordance with the output mode determined by the determining means, as recited in Claim 22.

Accordingly, Applicant submits that Claim 22 is patentable over Hayashi.

Independent Claim 29 is a method claim that corresponds to apparatus Claim 22 and is believed to be patentable for at least the same reasons as discussed above in connection with Claim 22.

Conclusion

A review of the other art of record including Teramoto and Kadota has failed to reveal anything that, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as applied against the independent claims herein. Therefore, those claims are respectfully submitted to be patentable over the art of record.

The other rejected claims in this application depend from one or another of the independent claims discussed above, and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual consideration of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,


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